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10/087,470	02/27/2002	Brian Tuchtenhagen	10012668-1	3010

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

LEE, CHEUKFAN

ART UNIT	PAPER NUMBER
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2627

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/087,470	Applicant(s) TUCHTENHAGEN, BRIAN	
	Examiner Cheukfan Lee	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-20 is/are allowed.
- 6) ☒ Claim(s) 1,9-13,21,22 and 25-32 is/are rejected.
- 7) ☒ Claim(s) 2-8,23 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-32 are pending. Claims 1, 9, 14, 21, 25, and 29 are independent.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 9-13, 21, 22, and 25-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Tanimoto (U.S. Patent No. 6,952,280).

Regarding claim 1, Tanimoto discloses an apparatus (2) comprising a primary media feed tray (tray 5) (col. 4, lines 19-21), a priority media feed tray (tray 6) (col. 4, lines 10-12 and 19-21), a media feed mechanism (inherent) configured to extract media from the priority feed tray (6) and the primary feed tray (5), and priority media release device (col. 4, lines 6-50) configured to selectively inherently block media in the priority feed tray from the media feed mechanism (col. 4, lines 40-50), and admit media in the priority feed tray to the media feed mechanism (col. 4, lines 36-39).

Regarding claim 9, Tanimoto discloses an apparatus comprising a primary media feed tray (tray 5) (col. 4, lines 19-21), a priority media feed tray (tray 6) (col. 4, lines 10-12 and 19-21), a media feed mechanism (inherent) configured to extract media from the priority feed tray (6) and the primary feed tray (5), a processor (in printing unit 4) (col. 4,

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lines 32-35), a priority media release device under control of the process (in printing unit 4) and configured to admit media resident in the priority feed tray (6) into the inherent media feed mechanism when authorized by the processor (col. 4, lines 32-40 and 19-21).

Regarding claims 10 and 11, in Tanimoto, the Fig. 4 flow chart corresponds to an actuating routine as claimed that is inherently stored in a computer readable memory device of the printer unit (4) (processor), the memory device inherently is in signal communication with the processor (in printing unit 4) (col. 4, line 51 – col. 5, line 28). The predetermined condition is that the print request is generated from the same client as that designated by designating unit (3), or that the print request is for a designated job which is to be printed on media designated as part of the condition (col. 5, lines 8-16).

Regarding claims 12 and 13, the determination of the type of paper loaded into the manual feed tray (6) or paper cassette (5) inherently includes detection of the presence of media in the priority media tray as claimed (col. 6, lines 4-10).

Regarding claim 21, an applications program as claimed is inherent in Tanimoto to generate an image file and a printer driver program as claimed is inherent to generate the printer job (file) from the generated image file (col. 5, lines 5-7 and 15-18, col. 4, lines 26-27, col. 5, lines 66 – col. 6, line 10). Please also refer to the discussion of claim 9. The media type designation (at designated at designating unit 3) is selectively applied to the image file and indicates the priority tray (6) as the source of the imaging

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media. The priority media release instruction is applied to the print job (file) when the image file indicates the priority tray (6) as the source of the imaging medium.

Regarding claim 22, the inherent applications program is configured to allow a user to apply the media type designation to the image file indicating the priority tray (6) as the source of the imaging media (Tanimoto, col. 4, lines 19-21, col. 5, line 66 – col. 6, line 10).

Regarding claim 25, the claimed method is disclosed by Tanimoto discussed above. Imaging media is provided in a priority media tray (6) (col. 4, lines 19-21). The image file is provided with a imaging media release command, and the imaging media from the priority media tray (6) is released to the imaging apparatus (printer) when the image file has an imaging media release command (Figs. 3 and 4, col. 4, line 6 to col. 5, line 28).

Regarding claim 26, the imaging file is imaged onto the released imaging media (col. 4, lines 36-40).

Regarding claim 27, as discussed for claim 21 above, an application software program for generating the image file is inherent in Tanimoto. A selected imaging media type for the image file is designated inherently using the application software program (col. 5, line 66 to col. 6, line 10). As a result of designating the selected imaging media type, the image file is automatically provided with the imaging media release command.

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Regarding claim 28, the claimed method steps are also disclosed by Tanimoto.

Please note that the primary media tray is the tray (5) (col. 4, lines 19-21) for the second image file (non-designated job) (col. 4, lines 40-50).

Regarding claim 29, the claimed method is also disclosed by Tanimoto. The primary media tray (5) and the priority media tray (6) each contain imaging media (also col. 4, lines 19-21). A print job is provided and received and the print job file is checked for the presence of a priority tray media release command is checked (col. 4, lines 32-40). The presence of image media in the priority media tray is inherently checked when the type of paper loaded into the tray (6) is checked and determined (col. 5, line 66 to col. 6, line 10). When imaging media is present in the priority media tray (6), and the priority tray media release command is present in the print job file, releasing the imaging media from the priority tray (6) and imaging the image file or file portion on the released imaging media (col. 4, lines 32-40).

Regarding claim 30, when the priority tray media release command is not present in the print job file, and the imaging media is present in the priority media tray, the imaging media from the priority media tray (6) is not released, and the image file or file portion is imaged on media from the primary media tray (col. 4, lines 40-50).

Regarding claim 31, when the priority tray media release command is present in the print job file, and imaging media is not present in the priority media tray (6), the print job file is spooled (saved in a memory device) (co. 4, lines 46-50).

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tanimoto (U.S. Patent No. 6,952,280) in view of Holt (U.S. Patent No. 5,495,561) and well known art.

Regarding claim 32, in Tanimoto discussed for claims 29 and 30 above, the print job file is spooled when the priority tray media release command is present in the print job and imaging media is not present in the priority media tray (6). Tanimoto differs from the claimed invention in that Tanimoto does not disclose re-checking for the presence of imaging media and retrieving the print job file from the memory device for imaging the file on the released imaging media. However, these claimed features are not novel.

First, the examiner took Official Notice of the fact that re-checking for the presence of imaging media in a paper tray so that a printing operation can be performed in case imaging media is present in the tray is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to re-check for the presence of imaging media in the priority media tray (6) of Tanimoto so that a printing operation can be performed.

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Holt teaches a printer handler, which contains a despoiler program which retrieves spooled data from a storage (522) to provide information to an imaging engine, after the print job has been spooled or stored in the storage (522) (col. 9, line 64 to col. 10, line 13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the method of Tanimoto in view of well known art with the steps of retrieving the print job file from the memory device, releasing the imaging media from the priority media tray (6) after re-checking for the presence of the imaging media in the priority media tray (6) and found that the imaging media are present there, and imaging the image file or file portion on the released imaging media, as taught by Holt.

6. Claims 2-8, 23, 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 14-20 are allowed.

8. The following is an examiner's statement of reasons for allowance:

Claims 2 and 8 would be allowable because the closest prior art reference Tanimoto (6,757,071) does not disclose a priority media release member selectively movable from a first position to a second position as claimed in the claimed in claims 2 and 8.

Claims 3-7 depending on claim 2 would be allowable for the reason given for claim 2.

Claim 14 recites limitations similar to those of claim 2. Thus, claim 14 is allowable for the reason given for claim 2.

Claims 15-20 depending on claim 14 are allowable for the reason given for claim 14.

Claim 23 would be allowable because the closest prior art Tanimoto (6,952,280) does not disclose that the applications program is configured to automatically apply the media type designation to the image file indicating the priority tray as the source of the imaging media as claimed.

Claim 24 depends on claim 23 and would be allowable for the reason given for claim 23.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wheeler (U.S. Patent No. 6,894,791)

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Wheeler (U.S. Patent No. 6,947,159)

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee whose telephone number is (571) 272-7407. The examiner can normally be reached on 9:30 a.m. to 6:00 p.m., Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cheukfan Lee
December 5, 2005

A handwritten signature in black ink, appearing to read "Cheukfan Lee", is written over a printed name. The signature is stylized with a large, looping initial "C".